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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Seifert

Serial No. 75/273,635

Jack Schuman, Esq. for Brian L. Seifert.

Sophia S. Kim, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Hohein, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Brian L. Seifert has filed an application to register
the term "E-CATALOG," in the stylized format reproduced below,

for "computer software for use in creating an electronic customer order catalog from which the customer may order merchandise and services and arrange for the delivery thereof."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the term "E-CATALOG" is merely descriptive of them.

Applicant has appealed. Briefs have been filed,² but an oral hearing was not requested. We affirm the refusal to register.

¹ Ser. No. 75/273,635, filed on April 14, 1997, which alleges a date of first use anywhere of January 1989 and a date of first use in commerce of October 20, 1994.

² Both applicant and the Examining Attorney have devoted a significant portion of their briefs to an issue not properly before the Board on appeal. Specifically, citing Section 41 of the Trademark Act, 15 U.S.C. §1123, which provides that rules and regulations for the conduct of proceedings in the Patent and Trademark Office shall not be inconsistent with law, applicant contends that Trademark Rule 2.84(a), under which the Commissioner granted the Examining Attorney's request after publication for restoration of jurisdiction so as to impose the mere descriptiveness refusal, is contrary to the provisions of Section 13(b)(1) of the Trademark Act, 15 U.S.C. §1063(b)(1), which state in relevant part that "[u]nless registration is successfully opposed ... a mark entitled to registration on the principal register ... shall be registered" However, inasmuch as the Board does not have jurisdiction to determine such issue, the proper recourse for applicant would have been to file a timely petition to the Commissioner under Trademark Rule 2.146(a). See TMEP Section 1702 ("Decisions on the rules and practice are specifically outside the province of the Trademark Trial and Appeal Board"). Accordingly, no further consideration will be given to applicant's assertion that the Commissioner impermissibly restored jurisdiction to the Examining Attorney to raise the issue of mere descriptiveness.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant, referring to a third-party registration for the mark "ECATALOG" for "computer software for generating remote sales by providing product information and prices for goods, such as computer software, for viewing on a personal computer generating orders for the goods,"³ maintains that the Patent and Trademark Office ("PTO") is being inconsistent in presently refusing registration. Applicant, moreover, not only insists that the Examining Attorney's basis for refusal is "patently absurd," but contends that the PTO "is estopped now from denying that the mark is not descriptive." Furthermore, while tellingly avoiding any discussion of the evidence offered by the Examining Attorney, applicant simply asserts, without any explanation, that "the mark now sought to be registered merely suggests applicant's business" and correctly notes that "suggestive marks have long been held to be registrable."

The Examining Attorney, on the other hand, contends that it is not inconsistent for the PTO to have allowed an earlier registration for essentially the same mark and goods "while refusing the applicant's mark at this time because circumstances in the computer industry have vastly changed even within the last several years." Thus, irrespective of whether

³ Such registration, which was originally cited under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), as a bar to the registration applicant currently seeks, subsequently was voluntarily surrendered by the registrant and has been cancelled.

the term "ECATALOG" (or its legal equivalent "E-CATALOG") "may have been newly coined and may not have been merely descriptive of the goods" when registered, the Examining Attorney urges that, "with the proliferation of electronic commerce, i.e. business conducted using computers and web sites via Internet and World Wide Web, the term has become merely descriptive as demonstrated by the submitted evidence."

With respect to such evidence, the Examining Attorney has made of record numerous excerpts, of which the following are representative, from her searches of the "NEXIS" database to show that the term "E-CATALOG" "merely describes the primary feature of the applicant's ... goods" (emphasis added):

"Distributors are starting to offer Web-based **e-catalogs** and Web storefronts that ... allow your users to view the products in your distributor's inventory transparently, as if the products were your own." -- VARBusiness, June 7, 1999;

"With the increasing use of e-mail promotions, customers' e-mailboxes are growing as cluttered as their physical mailboxes. To set its e-mail apart from the competition's, and reduce costs, in February computer cataloger Insight Enterprises introduced the **eCatalog**, an e-mail catalog with graphics that resembles a page from its printed catalog." -- Catalog Age, April 1, 1999;

"In the past two years, we no longer use the [printed] catalog for prospecting. Only existing customers that request it receive it. We're trying to go with **e-catalogs**. We'll send you the same thing via

e-mail that you would get via print. And it has Web links on it, so you can click through to either our page or the manufacturer's and get more information in real time, right there." -- Investor's Business Daily, April 1, 1999;

"This allows the developer, as well as the viewer, to customize **e-catalog** pages for the highest quality viewing and printing on the Web." -- EDGE: Work-Group Computing Report, February 15, 1999;

"The seminar will cover the current e-commerce marketplace, extending a Web site to accommodate e-commerce, identifying e-commerce opportunities and requirements, and setting up a Web 'storefront' using a Lotus Domino-powered **e-catalog** application developed by Sun & Son." -- Electronic Buyers' News, September 28, 1998;

"You can imagine why businesses that offer product catalogs to other businesses and consumers are looking at electronic ordering to improve customer service, save money and speed up supply chain delivery.

E-catalogs are a necessary treatment for the ills that plague companies selling to other companies.

....

E-catalogs provide the capability for companies to quickly order everything from pipe fittings and restaurant glasses to computers and office supplies." -- Supply Chain Report, September 3, 1998;

"[T]he company's site features an **e-catalog** containing products from Sager's previously released CD-ROMs. With the **e-catalog**, any user can perform parametric searches, compare product attributes, request samples and quotes, and place orders." -- Electronic Buyers' News, July 6, 1998;

"Elcom International's second subsidiary is a technology organization that licenses Pecos procurement processing system software to companies interested in creating **e-catalog** and e-commerce offerings." -- VARBusiness, July 6, 1998;

"In the second phase--where most sites are today--online transactions are all the rage, thanks in large part to professional off-the-shelf **e-catalog software**." -- Computer Shopper, July 1998;

"[T]he president of sales and marketing for Dallas-based Paymentech Inc.'s commercial card division ... says that the slow development of **electronic catalogs** has had an impact. 'There are just too many suppliers out there,' he says. 'Development of **e-catalogs** is key to growth, but catalogs are only where purchasing cards were four or five years ago.'" -- Credit Card Management, April 1998;

"GE Information Services ... is raising the curtains on its latest offering, a Web-catalog service. The **E-catalog** targets retailers." -- EDI News, November 24, 1997; and

"Zimmerman also demonstrated **e-catalogs**, which he called 'an interesting embodiment of the future of catalogs.'

"Zimmerman showed an **e-catalog** from Land's End

....

E-catalogs are not yet widespread
" -- WWD, July 9, 1996.

In addition, the Examining Attorney relies, in support of her position, upon dictionary definitions of the prefix "e-," which The Computer Glossary (8th ed. 1998) at 131 lists as meaning "(electronic-) The 'e-dash' prefix may be attached to

anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc.," and the word "catalog," which the electronic version of The American Heritage Dictionary of the English Language (3d ed. 1992) defines as "**a.** a list or itemized display, as of titles, course offerings, or articles for exhibition or sale, usually including descriptive information or illustrations. **b.** a publication, such as a book or pamphlet, containing such a list or display: *a catalog of fall fashions; a seed catalog.*"⁴ The Examining Attorney also relies, as evidence of mere descriptiveness, upon copies of several third-party registrations, which she made of record with the final refusal, "of marks on the Supplemental Register containing 'e' followed by a descriptive word." The registrations, which among other things involve such terms as "E-RECRUIT" for "on-line personnel recruiting services," "E-FAX" for "electronic transmission services in the nature of a facsimile mail service," "E-PRICING" for "providing business information services via a global computer information network featuring pricing information" and "E-SCHOLARSHIPS" for "on-line scholarship services," are claimed by the Examining Attorney to

⁴ Although such definitions were submitted for the first time with the Examining Attorney's brief, we have considered them inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ

"demonstrate the policy the [United States Patent and Trademark] Office has taken with this type of marks."

In the present case, it is our view that, when used on or in connection with applicant's "computer software for use in creating an electronic customer order catalog from which the customer may order merchandise and services and arrange for the delivery thereof," the term "E-CATALOG" immediately describes, without conjecture or speculation, a significant purpose, function or use of such goods, namely, that they create electronic catalogs. As the "NEXIS" excerpts plainly demonstrate and the dictionary definitions confirm, the term "E-CATALOG" is used to designate electronic catalogs and software used to create such catalogs. Clearly, to customers for applicant's goods, there is nothing in the term "E-CATALOG" which, in the context of software designed to create electronic customer catalogs, would be ambiguous, incongruous or susceptible to any other plausible meaning. In addition, and while not in themselves dispositive, the third-party registrations of record nevertheless reflect that, with the single exception of the now-cancelled registration relied upon by applicant, the United States Patent and Trademark Office has been consistent in treating, as merely descriptive, terms which

594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

consist of the prefix "e-" (signifying "electronic") and a word descriptive of the particular services or goods for which the term is registered.

Accordingly, because the term "E-CATALOG" conveys forthwith a significant purpose, function or use of applicant's "computer software for use in creating an electronic customer order catalog from which the customer may order merchandise and services and arrange for the delivery thereof," such term is merely descriptive of applicant's goods within the meaning of the statute.

Decision: The refusal under Section 2(e)(1) is affirmed.

G. D. Hohein

C. E. Walters

B. A. Chapman
Administrative Trademark
Trademark Trial and Appeal

Judges,
Board